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In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. .....

PETER A. ASSEFF

and

THE LUBRIZOL CORPORATION,

Petitioners,

vs.

JOHN A. MARZALL,
Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners pray that a Writ of Certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review the judgment entered by said Court on April 26, 1951 (R. 202A).

MATTER INVOLVED.

The judgment was entered upon an appeal taken by petitioners from the judgment of the United States District Court for the District of Columbia under date of October 17, 1949 (R. 22A) in an action brought by petitioners against Lawrence C. Kingsland, then Commissioner of Patents, under the provisions of 35 U. S. C. 63, R. S. 4915. By an order entered December 16, 1949 (R. 22A) John A. Marzall was substituted as party defendant as successor Commissioner of Patents.

By said action, individual petitioner Asseff as applicant and corporate petitioner The Lubrizol Corporation as his assignee, sought the allowance of an application for patent, then pending in the Patent Office, which had theretofore been refused by the Board of Appeals (R. 175A). The invention, as to which the application was thus refused, relates to a lubricating composition and is defined in several groups of claims. The present petition is concerned only with that group of claims, viz. 9 to 24 incl., which define the combined use in a lubricant of a specifically identified inhibitor or anti-corrosion agent with a detergent agent.

On the question of the patentability of these claims to a combination of ingredients, the Court of Appeals was sharply divided in opinion. Although the majority, by Circuit Judge Miller, recognized "that Cook's first application[1] said the detergent and anti-corrosion agent would offset each other," they nevertheless saw "no invention in adding to the Cook composition well known detergents or corrosion inhibitors." From this conclusion District Judge Wilkin (retired), sitting by designation, dissented:

> "The evidence is clear that Asseff was first in reducing to practice the specific ingredients that produced the desired result and constituted the invention. It seems contrary to the very spirit and purpose of patent law to allow the subsequent application of Cook the benefit of the earlier date of his application, the teaching of which was expressly contrary to the combination which constituted the invention."

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 3, 1925, 28 U. S. C. 347(a).

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[1] This application, which disclosed such inhibitor or anti-corrosion agent as a sole additive, was abandoned in favor of an application (now patent No. 2,344,392, R. 183A), filed after Asseff's invention, in which Cook, evidently instructed by Asseff, indicated that his inhibitor might be used along with a detergent.

QUESTIONS PRESENTED.

1. Are the criteria of patentable invention different in the case of a combination of ingredients forming a new composition of matter from those in the case of a combination of mechanical elements forming a new machine?

2. Can an admittedly new composition be held "the result of a natural course of experimentation," where the teaching of the prior art was that component ingredients of the type involved were incompatible, i.e., could not be used together?[2]

3. Specifically, can an admittedly new composition of matter which is characterized by the use in combination of a component A (a specific inhibitor) and a component B (a detergent) which are now shown unexpectedly to cooperate in providing desirable results, far beyond the cumulative effect when they are used separately, be held anticipated by adding together separate prior art teachings which respectively relate to the use separately of said components A and B, when that teaching which relates to component A, the inhibitor, states specifically that such components A and B cannot be used together because each "tends to offset the action of the other"?

REASONS RELIED ON FOR ALLOWANCE OF WRIT.

1. There is urgent need for a pronouncement by this Court of the law applicable to determine invention in "chemical combinations." Over the years in a series of cases the rule as to mechanical combinations has been well established so that it is possible to determine whether a particular combination of mechanical elements amounts to invention or is merely aggregation. However, as evi-

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[2] "The ability to predict results without experiment is a minimum with chemical compounds especially in the organic field and a maximum with chemical inventions." (See Ellis "Patent Claims" p. 576.) In the same comprehensive text not a single court decision is cited in the section entitled "Aggregation and Combination in Composition of Matter Claims." (Id. p. 599.)

denced by the lack of the citation of any authority in the opinion of the Court of Appeals here in question, there is no corresponding definite rule where chemical ingredients instead of mechanical elements are brought together.

2. Such a pronouncement is not only desirable for the instruction of the courts (and of the Patent Office) in dealing with chemical cases, but for the chemical industry as well. It is well known that major strides have been made by the American chemical industry since World War I. Those strides have been concerned largely with the synthesis of new chemical compounds and the development of and improvement in processes for the manufacture of known compounds. In recent years, the development of the chemical art has taken on a new complexion, that is, the achievement of specific results by the combined use of separate chemicals, each known to be useful for a particular purpose, but which when used together have a synergistic effect to produce a result not possible by the use of either alone.

3. It is well known and has long been recognized by the courts that while the results obtainable by the combination of mechanical elements may be determined by calculation, such determination beforehand is not true in the case where chemical ingredients are brought together. Accordingly it is only by experimentation that the effect of chemical combinations can be ascertained. It is important to know whether, just because a new and unexpected result is obtained by experimentation, such a discovery is to be denied the status of a patentable invention.

CONCLUSION.

For all of the foregoing reasons it is submitted that this petition for writ of certiorari should be granted.

Respectfully,

PETER S. ASSEFF AND
THE LUBRIZOL CORPORATION,

By JOHN F. OBERLIN,
ALMON S. NELSON,
Attorneys for Petitioners.

July 25, 1951.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

OPINIONS BELOW.

The opinion of the District Court (R. 13A *et seq.*) is reported in 86 F. Supp. 419 (1949). The opinion of the Circuit Court of Appeals (R. 202A *et seq.*) is reported in 89 U. S. P. Q. 206.

JURISDICTION.

The petition sets forth on page 2 the grounds upon which the jurisdiction of this Court is invoked.

STATUTE INVOLVED.

R. S. Sec. 4915 (35 U. S. C. 63) authorizing the action is printed as an appendix to this brief.

STATEMENT.

As indicated in the petition under Matter Involved, the claims of the Asseff patent application (R. 114A *et seq.*) may be divided into two groups. The first group, claims 1 to 5, were concerned broadly with the use in lubricating compositions of a certain specifically identified inhibitor with a detergent. While the original appeal related to both groups, the present petition is concerned only with the claims of the second group of which the following may be taken as typical:

> "9. A lubricating composition containing a characterizing amount of the product obtained by preparing the zinc salt of the reaction product of capryl alcohol with phosphorus pentasulphide and a separate detergent of the class consisting of oil-soluble organic compounds containing a metal atom directly attached to an element of the class consisting of oxygen and sulphur."

Lubricants thus defined are designed primarily for use under conditions of extreme stress such as high tem-

perature and pressure which are encountered for example in Diesel engines. When a refined, but chemically unfortified, mineral lubricating oil is used under such conditions of extreme stress, the oil will deteriorate, resulting in (1) the generation of acidic bodies which are corrosive and (2) the formation of deposits within the combustion chamber which impair operation of the engine.

The above quoted claim 9 of Asseff calls for the addition to or combination with a lubricating composition of two separate chemical ingredients. The first of these, which may be generally termed an inhibitor, is a chemical compound containing phosphorus, sulphur and zinc which reacts with the metal surfaces, such as the engine parts, to build up thereon a barrier film that physically excludes the acidic bodies formed in the lubricating oil from attacking the metal. The second added ingredient, defined as a detergent, is designed to prevent the deposition of gum and carbon, or minimize the formation of deposits which interfere with normal engine operation. It is essential that these two added ingredients be compatible, for if either interferes with the chemical action of the other no improvement in the lubricating oil is obtained. What Asseff discovered was that the specific inhibitor, defined as in the above quoted claim, was not only compatible with the detergent compound, but that such inhibitor cooperates with the latter in an unexpected way to keep the engine very much cleaner than would be possible were such detergent used alone.

At the time Asseff made this invention, two skilled workers in the art, Cook and Thomas, filed an application (R. 164A *et seq.*) for patent in which they were concerned with the use, by itself, in refined mineral oil of a material generally similar to the inhibitor component of the Asseff combination. In that patent application, Cook and Thomas said that this type of material could not be used in combination with an inhibitor because (R. 167A):

> "The function of a corrosion inhibitor is to cover the bearings and other corrodible surfaces of the automo-

bile engine with a passivating film that prevents corrosion of the metal by the organic acids and other corrosive oxidation products in the oil. On the other hand, a sludge inhibitor or a detergent as the name implies operates to remove adhering solids from the metal parts of the engine and thus to produce a clean metal surface. *Consequently, the use of a corrosion inhibitor in admixture with the detergents heretofore employed has proven to be ineffective over any extensive period of time, as each chemical tends to offset the action of the other.*" (Emphasis added.)

It is admitted that in the matter of date the foregoing Cook application is prior to Asseff's discovery. However such Cook application was abandoned and it was only in an application (now patent No. 2,344,392, R. 183A), filed by Cook subsequently to Asseff's discovery, that Cook for the first time recognized the possibility of combining his specific inhibitor with certain identified detergents.[3]

On the basis of the foregoing, two members of the Court of Appeals in ruling on Asseff's claims 9 to 24 here in issue, stated (Opinion p. 3):

"The fact that Cook's first application said the detergent and the anti-corrosion agent would offset each other might have the effect of showing that Cook was not prior art as to Asseff's Claims 9 to 24, if those claims were otherwise patentable; but that group of claims was rejected over the Cook and Salzberg patents in view of the patents to Wilson and McNab, which disclose the use of corrosion inhibitors in combination with detergent agents similar to those disclosed by Asseff.

"We see no invention in adding to the Cook composition well known detergents or corrosion inhibitors, as doing so is 'the result of a natural course of experimentation using the knowledge of prior patents.' *Asseff v. Kingsland*, 85 U. S. App. D. C. 367, 368, 178 F. (2d) 710, 711."

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[3] In the interval this had been disclosed but not claimed in Asseff's patent No. 2,261,047 (R. 177A).

However District Judge Wilkin[4] (retired) sitting by designation, sharply dissented (Opinion, p. 3):

> "The evidence is clear that Asseff was first in reducing to practice the specific ingredients that produced the desired result and constituted the invention. It seems contrary to the very spirit and purpose of patent law to allow the subsequent application of Cook the benefit of the earlier date of his application, the teaching of which was expressly contrary to the combination which constituted the invention."

Even had it been known (the contrary is the fact here) that corrosion inhibitors and detergents could be used together as additives in a lubricating composition, it would still be invention to discover a specific combination of such ingredients in which the corrosion inhibitor promoted, as it does in the Asseff composition, the action of the detergent. This clearly was a surprising and unexpected result.

SPECIFICATION OF ERRORS TO BE URGED.

The Circuit Court of Appeals erred:

1. In failing to define and apply a proper rule as to what constitutes patentable invention in the case of "chemical combinations."

2. In allowing the subsequent application of Cook the benefit of the date of his earlier application, the teaching of which was expressly contrary to the combination which constituted the invention here claimed.

3. In holding that Asseff's combination is anticipated by taking together prior art patents which show the use in lubricants of detergents and the Cook patent which is based on an application which contains the specific statement that inhibitors and detergents cannot be used in combinations since each such component offsets the action of the other.

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[4] Judge Wilkin, during over ten years service as a judge of the United States District Court, Northern District of Ohio, was recognized as specially qualified in the trial of patent cases.

4. In failing to hold that the claims of the Asseff patent which are directed to a combination of components which unexpectedly cooperate in providing desirable results, far beyond the cumulative effect when such components are used separately, ~~do not~~ define a patentable invention.

5. In affirming the order of the District Court.

ARGUMENT.

This petition reveals the existence of an important area in the field of patent law, wherein the decision below, if allowed to stand, materially and adversely affects a large and constantly growing segment of American industry, namely that concerned with the discovery and exploitation of new chemical compositions.

With respect to patents on mechanical combinations, this Court, by Mr. Justice Matthews, as far back as 1881, in *Pickering v. McCullough,* 104 U. S. 318 (1881) clearly defined what constituted patentable invention:

> "In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of invention, seized each of every part, per my et per tout, and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and cooperating action of all the elements, and which is not the mere adding together of separate contributions."

In the case of *Grinnell Washing Mach. Co. v. E. E. Johnson,* 247 U. S. 426, 432, 62 L. Ed. 1196, 1199 (1918), the Supreme Court said:

> "Generally speaking a combination of old elements in order to be patentable must produce by their joint action a new and useful result or an old result in a more advantageous way. To arrive at the distinctions between combinations and aggregations definite reference must be had to the decisions of this court."

There is a long line of cases which have laid down the rules to be followed in determining whether a particular combination of mechanical elements amounts to invention or is merely an aggregation.

If the law thus clearly established in mechanical cases were to be applied to the facts in the present case, there would result a clear ruling that what Asseff did amounted to invention. He brought together for the first time the components defined by the claims. They cooperate, and the results of such cooperation is a truly synergistic effect which cannot be secured by the use of either of the components alone, nor is the new synergistic effect merely the cumulative effect of the two components when used alone. However, the lower court in affirming the trial court held that this was not invention. The lower court cited no cases in support of its position. One would, therefore, be led to the assumption that the rule applicable to mechanical cases does not hold when considering chemical cases. There are no comparable holdings by this Court in which there ~~has~~ *ha* been laid down the criteria which determine invention in "chemical combinations." The urgent need for such a rule is self-evident.

Is it to be the rule, as in mechanical cases, that whenever an inventor brings together two chemical substances and observes unexpected cooperation or synergistic effect he has made an invention?

Or shall a new standard of invention be applied to chemical cases which, if the doctrine of the decisions of the lower court in the present case were to be followed, would practically preclude recognizing invention in any combination of chemical compounds regardless of how startling the unexpected results may be, since it could always be said that someone at some time in the future as a result of experimentation would probably put together these two materials?

If the rule to be followed in measuring invention in "chemical combinations" is to be different from the rule

to be followed in measuring invention in mechanical combinations, a definition of the new standard should be provided. If no different standards of invention are to be applied, then a pronouncement to that effect is required also.

CONCLUSION.

The court below has failed to recognize in the case of a chemical combination any rule of patentable invention comparable to that which has long been established by this Court in the case of mechanical combinations. It has compounded this error by refusing to recognize invention in a combination of chemical ingredients which the prior art taught could not be achieved.

The writ of certiorari prayed for should be granted.

Respectfully submitted,

JOHN F. OBERLIN,
ALMON S. NELSON,
Attorneys for Petitioners.

July 25, 1951.

APPENDIX.

Sec. 4915 R. S. (35 U. S. C. Sec. 63).

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, may have remedy by bill in equity, if filed within six months after such refusal or decision; * * * (R. S. 4915). (Mar. 2, 1929, c. 488, sec. 2(b), 45 Stat. 1476; August 5, 1939, c. 451, sec. 4, 53 Stat. 1212.)

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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 200

PETER A. ASSEFF and THE LUBRIZOL CORPORATION,
PETITIONERS

v.

JOHN A. MARZALL, Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the United States District Court for the District of Columbia (R. 13) is reported at 86 F. Supp. 419. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 203-205) is not yet officially reported.

JURISDICTION

The judgment of the Court of Appeals was en-

tered on April 26, 1951 (R. 206). The petition for a writ of certiorari was filed on July 24, 1951. The jurisdiction of this Court is presumably invoked under 28 U.S.C. 1254.

QUESTION PRESENTED

Whether petitioners' application for a patent was properly refused for lack of invention over the prior art.

STATUTE INVOLVED

R.S. 4886, as amended, 35 U.S.C. 31, provides as follows:

> Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

STATEMENT

This is an action under R.S. 4915, as amended, 35 U.S.C. 63,[1] against the Commissioner of Patents by the individual petitioner Asseff (the applicant) and the corporate petitioner, The Lubrizol Corporation (his assignee), to secure the allowance of the Asseff patent application, Serial No. 457,746 filed September 9, 1942, on an alleged invention in a "lubricating composition". The complaint was dismissed by the district court for want of invention over the prior art. The court of appeals affirmed.

1. *Petitioners' application.*—The application describes the alleged invention as one relating to lubricating compositions which are particularly suited for use under high temperature conditions such as those encountered in internal combustion engines of the Diesel types. The base constituent of the composition is a hydrocarbon oil, such as mineral lubricating oil, in which the minor constituent is a compound, the molecular structure of which includes the combination of zinc, the capryl alcohol radical and the dithiophosphate radical. Other compounds may be included in the composition such as detergents, pour point depres-

[1] "Whenever a patent on application is refused by the Board of Appeals * * * the applicant * * * may have remedy by bill in equity, * * * and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. * * *."

sors, and extreme pressure agents to meet particular problems of lubrication (R. 114-128, 13-14). The combination of zinc, the capryl alcohol radical and the dithiophosphate radical is denominated the characterizing agent of petitioners' composition (R. 118), the patentable element in their claims (R. 204), and is defined in all the claims as "the zinc salt of the reaction product of capryl alcohol with phosphorus pentasulfide" (R. 15).

The alleged invention is defined by the claims appearing in the complaint (R. 3-7). Although all the claims are in composition form, they fall into four groups as follows:

1. Claims 1 and 5 (R. 3-4) which call for a single addition agent, the zinc salt of dicapryl dithiophosphate;[2]

2. Claims 9 to 14 inclusive (R. 4-5) and 22 to 24 inclusive (R. 7) which are limited to the use of a second, further, addition agent in the composition, defined broadly as a "detergent of the class consisting of oil-soluble organic compounds containing a metal atom directly attached to an element of the class consisting of oxygen and sulphur" in claims 9, 10, 12 and 13; defined more specifically as "a calcium salt of a petroleum sulphonic acid" in claims 11 and 14, and as an oil-soluble "metallic phenate" in claim 22, which is still more specifically defined as a metallic phenate derived from an ester of "salicylic acid" in claim 23, and as "the mag-

[2] These claims do not form part of the subject matter of the instant petition for a writ of certiorari.

nesium phenate derived from lauryl salicylate" in claim 24;

3. Claims 15 and 16 (R. 5) which also require a second, further, addition agent, defined broadly in claim 16 as an "oil soluble organic corrosion inhibitor," and more specifically as a "halogen bearing organic compound having a vapor pressure less than atmospheric at 140° C." in claim 15; and

4. Claims 17 to 21 inclusive (R. 5-7) which require the presence in the composition of three addition agents, namely the zinc salt of capryl dithiophosphate, the detergent, and the corrosion inhibitor. In these claims, the detergent is defined broadly as in claims 9, 10, 12, and 13, while the corrosion inhibitor is defined broadly in claims 18 and 20, and more specifically, as in claim 15, in claims 17, 19 and 21.

All claims include, as an addition agent, the product obtained by preparing the zinc salt of the reaction product of capryl alcohol with phosphorus pentasulfide, and it is this product upon which petitioners base their contention of patentable novelty in the claims (R. 14).

2. *Prior art.*—On December 8, 1936, a patent, 2,063,629 (R. 190-193) was granted to Salzberg, *et al.* for a compound employed as a corrosion inhibitor in lubricants for bearings which operate under high pressure (R. 192, col. 2, lines 41-43). The patent relates to the production of acid esters and salts of dithiophosphorus acid. Zinc is mentioned as one of the metals forming the salt (R.

192, col. 2, line 19) and the ester portion is provided by aliphatic alcohols containing at least ten carbon atoms (R. 190, col. 1, lines 33-36). (R. 15.)

On July 14, 1942, a patent, 2,289,795 (R. 185-189) was issued to McNab, on an application filed September 1, 1939, for compositions related to improved lubricants for the lubrication of high pressure fuel injection engines such as Diesel engines. The patent discloses the use of a salt of a dithiophosphoric acid ester, especially calcium di-octyl dithiophosphate (R. 187, col. 2, line 70) in conjunction with metal soaps of natural and synthetic fatty acids and naphthenic acid (R. 186, col. 2, lines 56-61). It thus shows the use of a salt of dithiophosphate ester in which the alkyl radical contains eight carbon atoms (R. 187, col. 2, line 70). The McNab patent teaches that viscosity improving agents and pour point depressors may also be included for their particular function (R. 188, col. 2, lines 17-30). (R. 15.)

On April 21, 1942, a patent, 2,280,419 (R. 194-200) was granted to Wilson, on an application filed July 16, 1940, which describes a lubricant containing an oil soluble salt of the so-called "mahogany" sulfonic acids, including the zinc salt, together with oil soluble metal salts of thiophenols (R. 194, col. 1, lines 37-45). The sulfonic acids function as detergents, while the sulfur of the thiophenol imparts anti-corrosive properties (R. 197, col. 1, lines 35-43). (R. 15-16.)

On March 14, 1944, a patent, 2,344,392 (R. 183-184) was granted to Cook *et al.*, on an application filed November 8, 1941, as a continuation in part of a parent application filed July 11, 1941. This patent describes the preparation of heavy metal salts of the dicapryl ester of dithiophosphoric acid, and teaches that such salts are useful as sludge preventers and anti-corrosive agents for lubricating oils used in internal combustion engines (R. 183, col. 1, lines 8-11 and 42-47). Zinc is specifically mentioned as one of the heavy metals (R. 183, col. 1, lines 1-23). The heavy metal salts are stated to cooperate with heavy metal salts of diamyl phenol sulfides described in the Cook *et al.* patent 2,299,626, as well as with alkaline earth metal salts of petroleum sulfonates (R. 183, col. 2, lines 48-53). The dithiophosphoric acid ester salts are described as being good detergents which possess important non-oxidizing or anti-oxidant properties (R. 183, col. 1, lines 43-48), and are usable jointly with other detergents and corrosion inhibitors. (R. 16.)

3. *Proceedings below.*—Petitioners' claims were refused by the Patent Office examiner on the following grounds: (1) Claims 1, 5, and 9-24 were rejected as anticipated by the Cook patent; (2) Claims 9-24 were further rejected over the Cook and Salzberg patents in view of the patents to Wilson and McNab; and (3) Claims 16, 18, 20 and 21 were also further rejected as being too broad and indefinite as to the use of the term "corrosion

inhibitor" (R. 142-162). The decision of the examiner was affirmed on all grounds by the Patent Office Board of Appeals (R. 175-176).

Following the refusal of their patent application by the Patent Office, the instant suit was brought under R.S. 4915, 35 U.S.C. 63, against the Commissioner of Patents. After a *de novo* trial, the district court found (1) that petitioners' claims did not antedate the anticipatory effect of the Cook patent, which anticipates all of the claims; and (2) that petitioners' claims 9-24 lack invention and patentability over McNab, Salzberg and Wilson (R. 22). The court found it unnecessary, therefore, to pass upon the issue of petitioners' failure to meet statutory requirements relating to particularity and distinctness (R. 22). It accordingly dismissed the complaint. On appeal, the court below, one judge dissenting, affirmed, similarly holding that the Cook patent anticipated all the claims, and that claims 9-24, even if otherwise patentable, were properly rejected over the Cook and Salzberg patents in view of the patents to Wilson and McNab (R. 204-205).

ARGUMENT

It is a basic principle of patent law, applicable to the chemical field as well as to the mechanical, that a patent application which fails to disclose invention over the prior art is not patentable. *Mandel Bros.* v. *Wallace,* 335 U.S. 291; *Dow Chemical Co.* v. *Halliburton Oil Well Cementing*

Co., 324 U.S. 320; cf. *Funk Bros. Seed Co.* v. *Kalo Inoculant Co.*, 333 U.S. 118; see also *General Electric Co.* v. *Jewel Incandescent Lamp Co.*, 326 U.S. 242; *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147. Analysis of the opinions below reveals that no novel question of law is presented which requires resolution by this Court. The issue involved is the factual one of whether, applying this well-settled standard, petitioners' application discloses invention over the prior art. We submit that both courts below correctly held that, on the facts before them, petitioners' application lacks invention. Accordingly further review is not warranted.

Petitioners apparently concede that the Cook patent anticipates all of petitioners' claims as to the use of the zinc salt of the reaction product of capryl alcohol and phosphorus pentasulfide as an addition agent in a lubricant. Petitioners' basic contention here is that claims 9-24 are, nevertheless, patentable as an advance over the prior art by virtue of petitioners' alleged discovery that this specific corrosion inhibitor could be used together with detergents as additives in a lubricating composition (Pet. 9). This position is, we submit, completely belied by the record.

The prior art represented by Wilson (R. 194) and McNab (R. 185) recognized that the use of a plurality of additives in a lubricating oil composition was advantageous and gave improved results. In addition, Wilson recommended that compounds

containing halogen could be used with detergents for improved film strength (R. 199, col. 1, line 1). McNab taught the art the use of metal soaps in conjunction with a salt of dioctyl dithiophosphate far prior to petitioners' application for patent here in suit. Each of these patents teaches the conjoint use of a detergent and a corrosion inhibitor, and, further, McNab indicates that other addition agents, such as thickeners, viscosity index improving agents, and pour point depressors, may be included for their particular function (R. 188, col. 2, lines 17-30).

Salzberg (R. 190) relates specifically to methods for producing acid esters and salt esters of dithiophosphoric acid, and indicates that such compounds act as corrosion inhibitors in lubricants for bearings (R. 192, col. 2, lines 40-43). His disclosed invention embraced the acid esters and their salts such as the alkali, alkaline earth, calcium, zinc, lead and ammonium salts (R. 192, col. 2, lines 17-19).

Accordingly, the prior art was conversant with the use of salts of dialkyl dithiophosphate, and specifically dioctyl dithiophosphate. Since the alcohol used by petitioners in the preparation of the alkyl thiophosphate—capryl alcohol—is admittedly an aliphatic alcohol (R. 90) and an octyl alcohol (R. 88), the use thereof falls clearly within the disclosure of the prior art. The preparation and use of capryl ester was a logical and obvious

adaptation of the teaching of this prior art, requiring for its accomplishment only the skill of the art. Moreover, Salzberg indicated that zinc and calcium salts would be operative as corrosion inhibitors, and McNab substantiates that observation by his specification of calcium dioctyl dithiophosphate in conjunction with other additives for the same purpose. The substitution of the zinc salt for the calcium salt in McNab was well within the skill of the art, and even if improvement resulted, that alone is not the measure of inventive ingenuity. *Sonneborn Sons, Inc.* v. *Coe,* 104 F. 2d 230 (C.A.D.C.); *Rembert et al.* v. *Coe,* 136 F. 2d 793 (C.A.D.C.).

Petitioners argue that it is improper to reject their claims on a combination of these prior art teachings on the ground that the prior art expressly taught that they could not be combined (Pet. 7-9). But even assuming that petitioners' reliance upon the language appearing in the Cook parent application is properly placed (Pet. 7-8), and that the statement quoted really means that a combination of a dithiophosphate and a detergent is ineffective,[3]

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[3] When the statement in the Cook parent application, upon which petitioners rely, is placed in its proper context, the interpretation which petitioners give to it is shown to be without foundation. The Cook parent application discloses the discovery that oil-soluble heavy metal salts of dithiophosphoric acid esters, the basic addition agent of petitioners' claims, possess both detergent and corrosion inhibitor properties. After noting that the addition of small quantities of these salts, either alone or in admixture with other ingredients, to crankcase oil will effectively prevent the deposition of insoluble sludges while also inhibiting to a marked extent the

it is significant that McNab states that the conjoint use of the soap type detergent and thiophenolates gave superior results (R. 187, col. 1, lines 2-12). Since McNab teaches the equivalency of the thiophenolates and the thiophosphates, it would appear evident that the thiophosphates there disclosed would function in the same way. Hence, irrespec-

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oxidation of the oil (R. 165-167), the Cook parent application declares that (R. 167-168):

> It is interesting to compare the results obtained by the incorporation of small amounts of the heavy metal salts of dithiophosphoric acid esters in crankcase oils with the action of mixtures of dissimilar chemicals that have been added to oils in an attempt to accomplish the same purpose. Detergents such as calcium stearate, calcium napthenate and the like have previously been used in admixture with anti-corrosion agents such as triphenyl phosphite and sulfurized sperm oil *that have no detergent properties.* Although each of these two classes of materials will perform its function in a lubricating oil the two separate chemicals do not cooperate to produce a satisfactory anti-corrosion and detergent action when used together. The function of a corrosion inhibitor is to cover the bearings and other corrodable metal surfaces of the automobile engine with a passivating film that prevents corrosion of the metal by the organic acids and other corrosive oxidation products in the oil. On the other hand a sludge inhibitor or detergent, as its name implies, operates to remove adhering solids from the metal parts of the engine and thus to produce a clean metal surface. Consequently, the use of a corrosion inhibitor in admixture with the detergents *heretofore* employed has proven to be ineffective over any extensive period of time, as each chemical tends to offset the action of the other. [Emphasis added.]

In this setting, the language upon which petitioners rely states only that corrosion inhibitors which have no detergent qualities are incompatible with detergents. It plainly does not state that a corrosion inhibitor which does have detergent properties, such as the zinc salt common to the Cook and Asseff claims, is ineffective with detergents. Indeed, the Cook parent application specifically announces that this salt may be used "in admixture with other ingredients." (R. 165).

tive of what Cook may say, the prior teaching of McNab stands out as recommending that the metallic soap type detergent and the calcium salt of a dioctyl dithiophosphate conjointly used in a lubricating composition for Diesel engines would give superior results with respect to corrosion and sludge formation. Petitioners merely followed that teaching and the teaching of Salzberg when they used the zinc salt instead of the calcium salt disclosed by McNab. Following in the path blazed by the prior art, in the manner suggested by the prior art, does not exhibit that degree of creative ingenuity characterized by the term invention. Cf. *Mandel Bros.* v. *Wallace, supra; Asseff* v. *Kingsland,* 178 F. 2d 710 (C.A.D.C.); *In re Asseff,* 36 C.C.P.A. 867, 81 U.S.P.Q. 112.

CONCLUSION

This case involves no issue of significance beyond its particular facts, and the decision below is clearly correct. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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AUGUST, 1951.

☆ U. S. GOVERNMENT PRINTING OFFICE: 1951 943092 120